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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,681	01/10/2002	Guoqing Chen	A-733A	1839

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U.S. Patent Operations/JWB
Dept. 4300, M/S 27-4-A
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EXAMINER

RAYMOND, RICHARD L

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/046,681	Applicant(s) CHEN ET AL.	
	Examiner Richard L. Raymond	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 and 40-69 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-9,12-15,23-34,36-38,40-42,56,57 and 64-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,10,11,16-22,35,43-55 and 58-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/02, 10/14/02, 12/18/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Restriction/Election of Species

1. Pursuant to the requirement for restriction, applicants have elected the invention of Group I without traverse. As noted by applicants, claims 43-45 should have been included in Group I and claim 38 in Group II. Accordingly, claims 36-38, 40-42 and 64-68, drawn to methods of use, stand withdrawn from further consideration as being to a nonelected invention.
2. Pursuant to the requirement for election of species, applicants have elected the compound of Example 946, a compound where the A ring is a pyridyl ring. Claims 1, 4, 5, 10, 11, 16-22, 35, 43-55 and 58-63 are readable thereon. Claims 2, 3, 6-9, 12-15, 23-34, 56 and 57 stand withdrawn as not being readable on the elected species.

Improper Markush Rejection

3. Claims 1, 4, 5, 10, 16, 21, 22, 35, 55, 58 and 60-63 are rejected as being improper Markush claims in the definition of the A ring as diverse heterocyclic rings as well as naphthyl and cycloalkenyl rings. So substituted, the resulting total compounds lack a common core and read on structurally diverse and patentably distinct compounds. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Further, an undue search burden is involved as searches in various subclasses in compound classes 540, 544, 546, 548, 549, 558,

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560, 562 and 564, the corresponding subclasses in composition class 514, and diverse structures in the literature (STN/CAS) would be required. Limitation of the claims to compounds where the A ring is a pyridyl ring, encompassing the elected species, will overcome this rejection.

Obviousness-type Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, 5, 10, 11, 16-18, 35, 43-55 and 58-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the compound and composition claims of copending child Application No. 10/197,974. Although the conflicting claims are not identical, they are not patentably distinct from each other because common species are present in both sets of claims which anticipate one another. When not anticipated, the genus of one renders the claims of the other obvious. The motivation for selection comes from the common specifications.

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6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 4, 5, 10, 11, 16-18, 35, 43-55 and 58-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Betageri et al. See Column 47, compound 879, and the corresponding STN/CAS printout.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1, 4, 5, 10, 11, 16-22, 35, 43-55 and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betageri et al., above. Where not anticipated, one would be motivated to prepare the present compounds from within the genus of the reference (see formula I and the R⁴ definition as pyridyl) and/or to prepare the simple alkyl homologs, halo analogs and position isomers of the specific compounds of the reference with the reasonable expectation of obtaining additional useful anti-inflammatory agents (the use of the reference compounds). In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Potential Interference

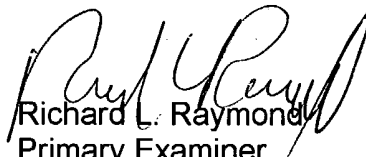
12. The Manley et al. U.S Patent No. 6,624,174 and Beight et al. U.S. Patent No. 6,689,780 appear to claim subject matter within the present claims. Since the effective filing dates of the patents are subsequent to the effective filing date of the present application no prior art rejection has been made; however, since two patents cannot issue on the same invention, interference proceedings may be necessary.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (571) 272-0673. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Richard L. Raymond
Primary Examiner
Art Unit 1624

rr
November 12, 2004